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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,051

10/12/2004

Yukio Nakagawa

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21171 7590 03/21/2007  
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EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/511,051

Applicant(s)

NAKAGAWA ET AL.

Examiner

David J. Joy

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6,8-11 and 24-26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-6, 8-11 and 24-26 are pending as amended on February 21, 2007, Claims 7 and 12-23 being cancelled. Claims 1-6, 8-11 and 24-26 are subject to a restriction requirement, and consequently, Claim 26 is withdrawn from consideration.

#### *Continued Examination Under 37 CFR 1.114*

2. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), and a submission (amendment), filed on February 21, 2007. The request has been deemed proper and this application has been hereby examined in view of said amendment.

#### *Election/Restrictions*

3. Newly submitted Claim 26 is directed to an invention which falls within the original Group III, as set forth in the original *Election/Restriction* requirement required under 35 U.S.C. 121 and 372, dated January 31, 2006. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, Claim 26 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

*Response to Amendments*

4. The objection to Claim 24 is withdrawn as Claim 24 has been amended to overcome that objection.
5. The rejection of Claims 8 and 24 under 35 U.S.C. §102(b) as being anticipated by the Japanese Patent Application of Takazono et al. (JP 2001-055202; hereinafter "Takazono") has been withdrawn.
6. The rejection of Claims 1-6 and 9-11 under 35 U.S.C. §103(a) as being obvious over Takazono in view of the U.S. Patent Application Publication of Zimmerman et al. (2003/0229543; hereinafter "Zimmerman") has been withdrawn.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 recites the limitation "the reader" at the end of the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6, 8-11, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. Patent of Cremon et al. (6,802,659; hereinafter "Cremon").

11. Cremon teaches a roll of packaging material including a holder, a strip of packaging material wound around the holder and a recording medium provided on the

holder. The recording medium electromagnetically records packaging related information that is readable from the recording medium in a non-contact fashion through a resonance phenomenon of radio waves while the strip is wound around the holder (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 48-55). Cremon also teaches that the packaging related information includes packaging conditions, material information, fabrication information and product identification (see Column 5, Lines 40-46; see also Column 8, Lines 7-23). In addition, Cremon teaches that the holder has a hollow core and that the recording medium can be located on an inner surface of the hollow core, including along the outermost periphery of the inner surface (see Figures 4 and 5; see also Column 7, Lines 56-62).

12. Cremon teaches that the roll of packaging material with a hollow core having an inner surface and an outer surface, a strip of packaging material wound around the outer surface of the hollow core and a recording medium on the inner surface of the hollow core such that the recording medium is readable in a contact fashion while the strip is wound around the hollow core (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 40-55). Cremon recites that the reader is integrated into the roll of material (i.e., on a support onto which the hollow core is placed) and that the reader reads the recording medium electronically, but there is nothing taught which

does not permit the fact that the internally integrated reader and the internally positioned recording medium would not come into contact with one another while the roll of material is in motion.

13. Cremon teaches that the roll of packaging material is supportable by a support shaft with the roll having a hollow core with an inner surface and a strip of packaging material wound around the hollow core and a recording medium provided on the inner surface of the hollow core. The recording medium has packaging related information that is readable from the recording medium in a non-contact fashion through a resonance phenomenon of radio waves while the strip is wound around the holder (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 48-55; see also Column 8, Lines 7-31). As for the claimed limitations that support shaft have a recording device provided thereon, and that it be on an outer surface of the support shaft, these limitations are deemed as being directed to a possible future use for the roll of packaging material. The limitations actually relate more so to features that an apparatus onto which the roll of packaging could be loaded then to the claimed limitations of the roll itself. As Cremon teaches that the roll has all of the claimed limitations in the instant application, and that the roll is supportable by a support shaft, it follows that the teachings of Cremon anticipate the support limitations as well.

14. In Claims 1-6 and 8, the recitation of such phrases as "for use in forming a package containing a product" (Claim 1) and "for packaging the product using said strip of packaging material" (Claim 2) does not positively recite any definite structure over that which is taught by the Cremon patent. Applicant has simply recited a condition for packaging the product, which merely refers to the intended use of the recording medium. Furthermore, Applicant has not positively recited a *product* but only a *material* that could potentially be used *in packaging a product* which defines nothing structurally distinct over that of the packing material as taught by Cremon.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EDT.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

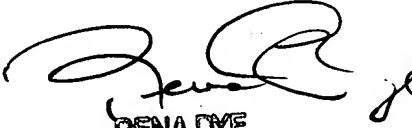


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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJJ

03/16/2007

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
Art Unit 1774